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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,787	08/17/2003	Larry W. Collum		1786

7590 08/26/2004  
Richard L. Bigelow, Esq.  
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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/604,787

Applicant(s)

COLLUM ET AL.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-13, drawn to a golf club, classified in class 473, subclass 282.
- II. Claim 14, drawn to a method of for using a golf club, classified in class 473, subclass 409.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of a golf club and method of using a golf club are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method as claimed can be used for other pitching wedges.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Richard L. Bigelow on 24 August 2004 a provisional election was made without traverse to prosecute the invention of the golf club, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Oath/Declaration***

5. It was not executed in accordance with either 37 CFR 1.66 or 1.68. The oath is not signed.

***Specification***

6. The disclosure is objected to because of the following informalities:

- a. Throughout the specification there are missing spaces between sentences (i.e. paragraph 0004 lines 10, 13, 16, 18, 31, etc...).
- b. In paragraph [0005] line 1 the word "SLES" does not make sense.

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c. In paragraph [0006] lines 11-12 the word "Figure 2." in the middle of the paragraph does not make sense.

d. In paragraph [0004] line 1 the words "INVENTIONT" and "Whe" are misspelled.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liao in view of Bamberger, Marciniak, Honma and Mason.

Liao discloses a club used for chipping [0002] having a loft angle of 38, 44 and 50 degrees (Fig. 6, Claim 1), a lie angle of 68 degrees (Fig. 7, Claim 1), and a shaft length of 34 inches or so ([0023, line 1]).

Liao lacks a shaft length of 36.5 inches, a metallic base plate attached to a wooden head with at least two screws, a wood head being persimmon, and a plastic insert placed in and adhesively attached to an indentation of a face of a head.

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Bamberger discloses a club having a length of 35 inches (Col. 2, Lns. 37-38) used for chipping (Abstract) having a wood type construction using material other than metal and a solid head construction while attaining the general shape of a wood head (Col. 4, Lns. 37-42) in order to glide through and/or along grass, sand, or even dirt surfaces more easily and consistently than an iron when used by a golfer (Col. 3, Lns. 1-6). In view of the patent of Bamberger it would have been obvious to modify the club of Liao to have a wooden type head in order to have a club which glides through and/or along grass, sand, or even dirt surfaces more easily and consistently than an iron when used by a golfer.

Marciniak discloses wooden type head being formed of a persimmon (Col. 2, Lns. 27-28) having a sole plate attached with at least two screws (Fig. 3) and a face plate made of plastic adhesively attached to an indentation in the form of cemented (Col. 3, Lns. 27-35). In view of the patent of Marciniak it would have been obvious to modify the club of Liao to have head made of solid material of persimmon in order to utilize the advantages of persimmon wood for a golf head. In view of the patent of Marciniak it would have been obvious to modify the club of Liao to have a sole plate attached to a wooden head with at least two screws in order to protect the bottom of the head from rocks. In view of the patent of Marciniak it would have been obvious to modify the club of Liao to have a plastic insert placed in and adhesively attached to an indentation of a face of a head in order to have elastic properties for a face which plastic produces.

Honma discloses a sole plate being metallic (Col. 2, Lns. 62-68). In view of the patent of Honma it would have been obvious to modify the head of Liao to

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have a sole plate being metal in order to utilize a material used in the art for making base plates attached to wooden heads.

Mason discloses clubs for pitching having a shaft length between 35 and 40 inches (Col. 4, Lns. 36-40). In view of the patent of Mason it would have been obvious to modify the club of Liao to have a shaft length being 36.5 inches in order to fit a golfer whose hands have a higher vertical height.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 24 August 2004

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**